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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/581,175

10/07/2008

Jerome Cassayre

70313/UST

1585

85981 7590 10/14/2011

Syngenta Corp Protection, Inc.
410 Swing Road
Greensboro, NC 27409

EXAMINER

DESAI, RITA J

ART UNIT

PAPER NUMBER

1625

MAIL DATE

DELIVERY MODE

10/14/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/581,175	Applicant(s) CASSAYRE ET AL.	
	Examiner RITA DESAI	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ An election was made by the applicant in response to a restriction requirement set forth during the interview on ____; the restriction requirement and election have been incorporated into this action.
- 4) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 5) ☒ Claim(s) 1-19 is/are pending in the application.
- 5a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 6) ☐ Claim(s) ____ is/are allowed.
- 7) ☒ Claim(s) 1-19 is/are rejected.
- 8) ☐ Claim(s) ____ is/are objected to.
- 9) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 10) ☐ The specification is objected to by the Examiner.
- 11) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 12) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/28/11, 7/20/06</u> | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

Election/Restrictions

Applicants argument that the search is not burdensome is notconvincing.

The application is a 371 and not a 121 .

See WO 03/106457.

The core is not novel.

The examiner has rejoined claim 8 drawn to formula II.

The restriction is made FINAL.

Priority

Applicant is advised of possible benefits under 35 U.S.C. 119(a)-(d), wherein an application for patent filed in the United States may be entitled to the benefit of the filing date of a prior application filed in a foreign country.

Applicants have not checked the priority box in the OATH nor do they have it in their specifications even though they have it listed in the OATH.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-7, 9-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Caplus

English Abstract. AN 1952:57258 CAPLUS

DN 46:57258

TI The synthesis of a physostigmine like compound

Art Unit: 1625

AU Kretz, E.; Muller, J. M.; Schlittler, E.

CS Univ. Basel, Switz.

SO Helvetica Chimica Acta (1952), 35, 520-8

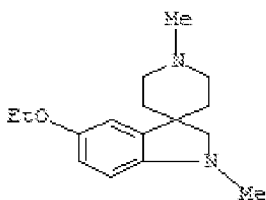
The reference discloses several compounds such as

RN 860420-54-8 CAPLUS

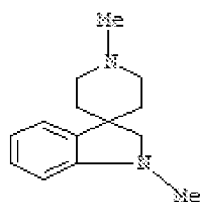
CN Spiro[3H-indole-3,4'-piperidine], 5-ethoxy-1,2-dihydro-1,1'-dimethyl- (CA
INDEX NAME)

Art Unit: 1625

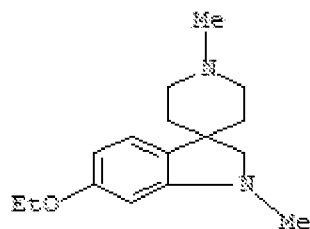
AN 1952:57258 CAPLUS Full-text
 DN 46:57258
 GREF 46:9571d-1,9572a-b
 TI The synthesis of aphysostigminelike compound
 AU Kretz, E.; Muller, J. M.; Schlittler, E.
 CS Univ. Basel, Switz.
 SO Helvetica Chimica Acta (1952), 35, 520-8
 CODEN: HCACAV; ISSN: 0018-019X
 DT Journal
 LA German
 IT 860420-54-8, Spiro[indoline-3,4'-piperidine],
 5-ethoxy-1,1'-dimethyl-
 (and hydrochlorides)
 RN 860420-54-8 CAPLUS
 CW Spiro[3H-indole-3,4'-piperidine], 5-ethoxy-1,2-dihydro-1,1'-dimethyl- (CA
 INDEX NAME)



IT 845825-82-3, Spiro[indoline-3,4'-piperidine], 1,1'-dimethyl-
 (and salts)
 RN 845825-82-3 CAPLUS
 CW Spiro[3H-indole-3,4'-piperidine], 1,2-dihydro-1,1'-dimethyl- (CA INDEX
 NAME)



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These compounds read on the applicants compounds wherein Y is a bond and R1 is an alkyl, R8 is an alkyl, R4 is an alkoxy.

Claims 1-7, 9 are rejected under 35 U.S.C. 102(b) as being anticipated by English
Abstract Ono Keiichi et

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al.e

AN 1978:529425 CAPLUS Full-text

DN 89:129425

ORZF 89:20025a,20028a

TI Spirocamine derivatives

IN Ono, Keiichi; Sasajima, Kikuo; Matsube, Junki; Yamamoto, Hisao

PA Sumitomo Chemical Co., Ltd., Japan

SO Jpn. Kokai Tokkyo Koho, 10 pp.

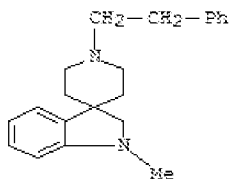
CODEN: JKNXAF

BT Patent

LA Japanese

FAN.CNT 1

	PATENT NO.	KIND	DATE	APPLICATION NO.	DATE
PI	<u>JP 53068784</u>	A	19760619	<u>JP 1976-144149</u>	19761130 <--
	<u>GB 1575800</u>	A	19801001	<u>GB 1978-19959</u>	19785516 <--
PRAI	<u>JP 1976-144149</u>	A	19761130		
IT	<u>87677-63-8P</u>		<u>87677-69-6P</u>	<u>87677-70-7P</u>	
	RL: SPN (Synthetic preparation); PREP (Preparation)				
	(preparation of)				
RN	<u>87677-63-8</u>	CAPLUS			
CN	Spiro[5H-indole-6,4'-piperidine], 1,2-dihydro-1-methyl-1'-(2-phenylethyl)-, hydrochloride (1:1) (CA INDEX NAME)				

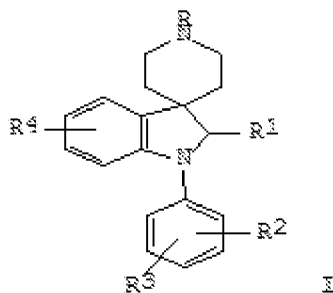


The reference reads on the compounds when Y is a bond. R8 is an substituted alkyl or a substituted aryl.

Claim1-7 and 9 are rejected under 35 U.S.C. 102b) as being anticipated by US 4307235

Helen Ong et al.

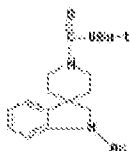
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The reference discloses which reads
 on the applicants compounds when Y is a bond, R1 is a phenyl (aryl) and R = H, alkyl,
 cyano, alkanoyl, CO2Ph, phenylalkyl, phenylalkanoyl, alkenyl,
 cycloalkylalkyl, .omega.-benzoylalkyl (or its ethylene ketal

Claims 1-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Meng-Hsin Chen.

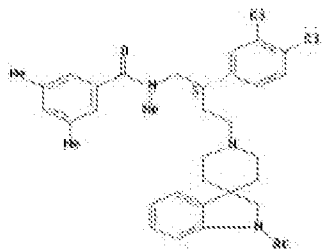
The reference discloses the compound wherein R8 is an alkoxy carbonyl, R1 is a alkoxy ,
 Y is a carboxy group.



Claims 1-7, 9 are rejected under 35 U.S.C. 102(b) as being anticipated by MacCoss Malcolm et al.. WO 9429309.

The reference discloses

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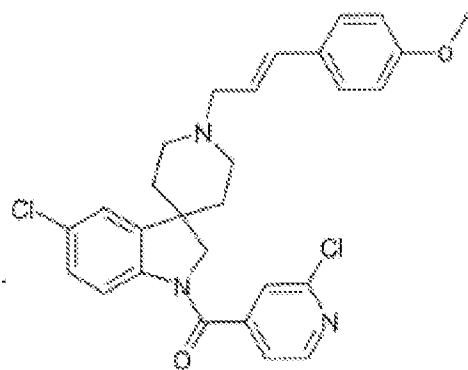
Again R8 is a substituted alkyl or a substituted aryl.

Claims 1-7, 9 are rejected under 35 U.S.C. 102(a) as being anticipated by WO 03/106457 published 12/12/03, as applicants OATH does not have the priority box checked.

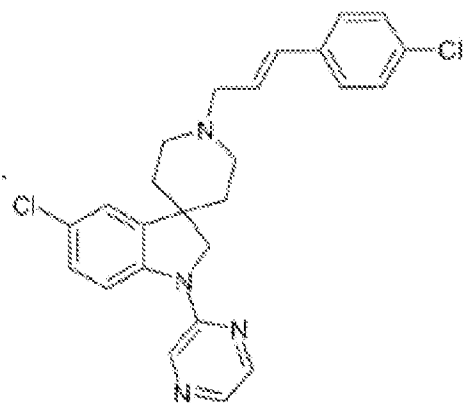
And if they do claim their priority that it is a 102(e) (filing date.)

The applied reference has a common inventors with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

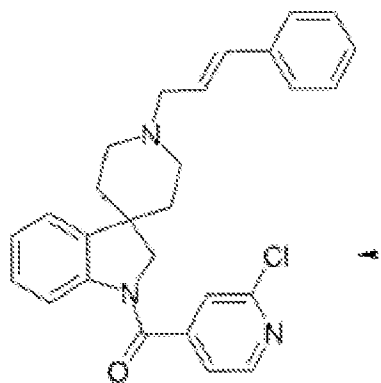
See example 10 on page 117.



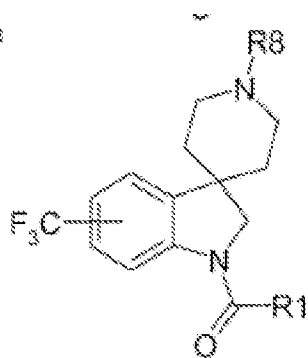
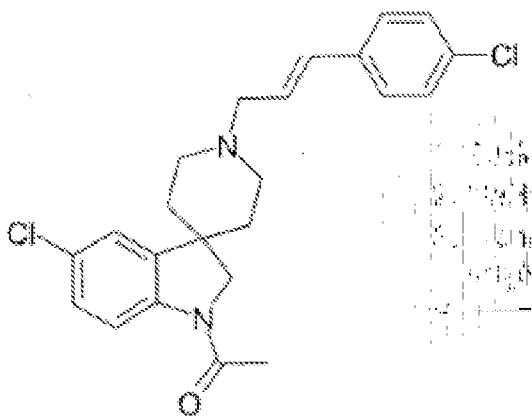
Eg 5 page 110.



Example 2,



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See tables 1, 2 , 3 .

See whole document.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim s 1-7 and 9 are rejected under 35 U.S.C. 103(a) as being obvious over WO 03/106457. The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention “by another”; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

See the above 102 (e) rejection.

The reference discloses several compounds which read on the applicants compounds.

The generic formula is also disclosed.

One of skill in the art would be motivated to make addition compounds with different combinations to make new compounds.

Double Patenting

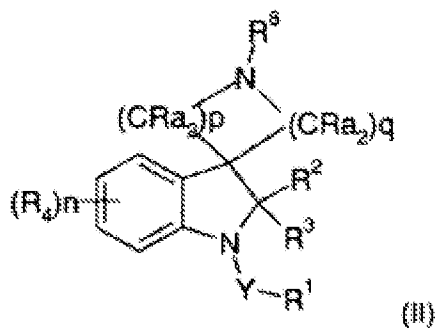
The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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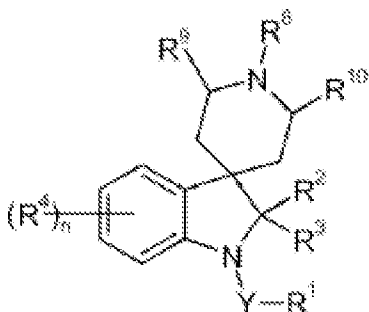
Claim 1-7, 9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 9, 10 and 11 of copending application US 10/581174. Although the conflicting claims are not identical, they are not patentably distinct from each other because they encompass the same scope, Y is a C=O and R¹ and R⁸ have the



same overlapping definition.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

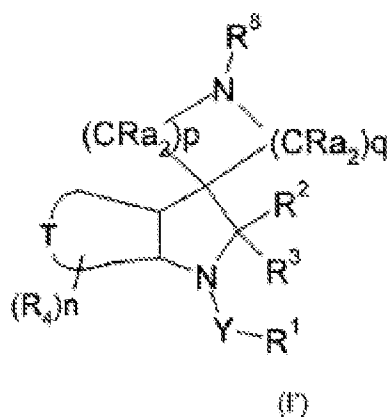
Claims 1-7, 9 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 8 of copending Application No 10/517957. Although the conflicting claims are not identical, they are not patentably distinct from each other because compounds have a very close structural similarity.



This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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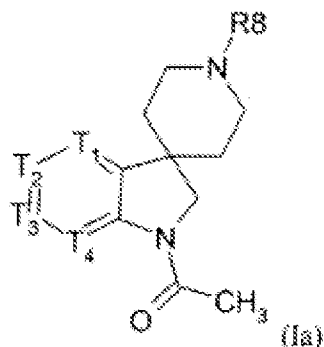
Claims 1-7 and 9 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 10,11 of U.S. Patent No.7960401. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compounds have a very close structural similarities and overlapping subject matter.



See compounds in table 1.

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Table I provides 575 compounds of formula Ia



15

wherein T1 is N, T2 is CR^{4a}, T3 is CR^{4b}, T4 is CR^{4c} and the values of R⁸, R^{4a}, R^{4b} and R^{4c} are given in Table I.

Table I

Compound No	R ⁸	C-R ^{4a}	C-R ^{4b}	C-R ^{4c}
I-1	4-chlorobenzyl	CH	CH	CH
I-2	Cinnamyl	CH	CH	CH
I-3	4-chlorocinnamyl	CH	CH	CH
I-4	4-fluorocinnamyl	CH	CH	CH
I-5	4-bromocinnamyl	CH	CH	CH
I-6	4-trifluoromethylcinnamyl	CH	CH	CH

which would be included in the scope of the generic claim.

Conclusion

Claims 1-19 are rejected.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to RITA DESAI whose telephone number is (571)272-0684. The examiner can normally be reached on Maxi- flex time..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Andres can be reached on 571-272-0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Rita J. Desai/
Primary Examiner, Art Unit 1625

October 10, 2011